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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,911	01/09/2002	Shana O. Kelley	2846/1032	4527

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EXAMINER

FORMAN, BETTY J

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/042,911

Applicant(s)

KELLEY ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
 2. ☒ The proposed amendment(s) will not be entered because:  
 (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ they raise the issue of new matter (see Note below);  
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
 6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
 7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-14, 16-43, 60 and 61.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
 9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
 10. ☐ Other: \_\_\_\_\_

BJ Forman  
 Primary Examiner  
 Art Unit: 1634

Continuation of 2. NOTE:

The amendments add limitations to the claims not previously considered e.g. "electrically conducting" carbon nanotube: "pair of carbon" nanotubes; "provides electrical connectivity between the pair of nanotube tubules" While the previous claims were drawn to an electrically conductive biological compound, the previous claims were not limited to "an electrically conducting carbon nanotube array comprising at least one pair of carbon nanotube tubules". Hence, the amendments further define the array. Because these limitations have not previously been considered, they would require further search and consideration.

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant traverses the Finality of the previous office action because the new grounds for rejection under 35 U.S.C. 112, first paragraph were not necessitated by amendment. Applicant cites a rejection in the first office action, under 35 U.S.C. 112, second paragraph, of the recitation "said proximal ends being attached" and suggested the claim be amended to delete "being". Applicant asserts that the office did not question a supportive teaching in the specification of "attached" in that first office action. Applicant further asserts that "directly" attached merely clarifies the mode of attachment i.e. "without a linker" and as such, the term "directly attached" is not new matter.

The argument has been considered but is not found persuasive. As noted by Applicant, in the first office action, the office rejected "being attached" as indefinite and suggested deletion of the word "being". However, the office did not suggest replacing "being" with "directly". Applicant responded to the indefinite rejection by replacing "being" with "directly". As discussed in the final office action, the phrase "directly attached" encompasses numerous means of attachment not described by the specification. While the phrase does encompass "without a linker" the claims, as written, are not limited to such an embodiment. Because the specification does not describe the phrase ""directly" attached", the phrase introduces new matter.

Applicant's arguments regarding the rejections under 35 U.S.C. 103 have been reviewed. However, because they address the claims as amended and because the amendments have not been entered, the arguments are deemed moot.

  
BJ FORMAN, PH.D.  
PRIMARY EXAMINER